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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,102	08/17/2001	Akiho Mitsuteru	PHJ 99,028	5484

7590

04/07/2003

U.S Philips Corporation  
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EXAMINER

ALAVI, ALI

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/932,102

Applicant(s)

MITSUTERU, AKIHO

Examiner

Ali Alavi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's response filed on 12/10/02 has been fully considered and found persuasive and therefore objection to drawing has been withdrawn. However, there is raised a new ground of rejection under 35 USC 112 1<sup>st</sup> paragraph for enabling of parasitic capacitance in which is considered a physical property of a subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, the indicated allowability of claims 1-5 is withdrawn in view of the 112 1<sup>st</sup> paragraph in which will be described in more details below.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/17/1999. It is noted, however, that applicant has not filed a certified copy of the Japan application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. Claims 1-5 recites in part "...wherein the light sources are provided so as to have the same parasitic capacitance caused by intervals between the light sources and the light reflection member." This limitation was not given patentable weight because it is unclear as to how parasitic capacitance works in the absence of unexpected test results or any theoretical formula to support this limitation.

Furthermore, Applicant responded that the parasitic capacitance is not an object but it is a physical property like mass, charge, density, etc. Moreover, physical property of matters are not given patentable weight because matters are inherently contain specific physical properties unless they are supported by any unexpected test result in which renders it unobvious. Applicant may amend the specification to include support for the parasitic capacitance without entering a new matter into the specification.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (US pat. No 6,390,638 B1).

Miller discloses a device for illuminating a flat panel display including a light guide (210, fig. 2), and three or more light sources (160, 170, fig. 2), provided at at least one of side ends of the light guide plate, and a light reflection member (220, fig. 2)

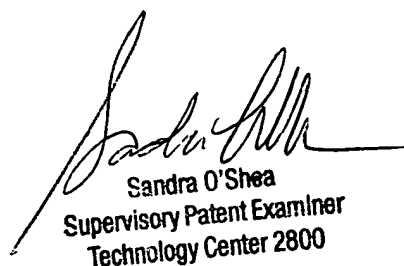
surrounding the light sources, that reflects light emitted from the light sources to the light guide plate. Miller discloses the invention as claimed but shows only two light sources instead of three light sources. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add more than two light sources since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nagatani (US Pat. Application 2001/0052955) discloses a baklight unit including a plurality of light sources whose luminescent characteristics are different.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Ali Alavi whose telephone number is (703) 305-0522. The examiner can normally be reached between 8:00 A.M. to 4:030 P.M. Monday to Friday. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached at (703) 305-4939 or you may fax your inquiry to the receptionist at (703) 308-7382.

Ali Alavi



Sandra O'Shea  
Supervisory Patent Examiner  
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3/22/03